



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

gn

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,923	11/06/2001	H. Darrel Darby	A7971	4566

7590 12/21/2004

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER
----------

PHAM, HUONG Q

ART UNIT	PAPER NUMBER
----------	--------------

3764

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/985,923

**Applicant(s)**

DARBY, H. DARREL

**Examiner**

Huong Q. Pham

**Art Unit**

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6- 8, 10, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Oster et al ( 5,425,701). As for claims 1, 10, 19, Oster et al teaches every claimed feature of claims 1, 10, 19 including an outer sole 42 ( figure 4), a rigid immobilization plate 30 ( and 28) with a bottom portion having a back end , a back portion 34( figure 2) formed by a back part “integrally formed” with side parts 32 , and a boot portion 26 ( figure 5) attached to the rigid immobilization plate, strap 90 & means for attaching the strap. As for claims 2, 4, note figure s 2, 5. As for claim 6, note figure 6. As for claims 7, 8, note that “ breathable “ and “ semi- flexible’ are relative terms.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 9, 11-13, 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oster et al. As for claims 3, 5, 15, note that the boot portion of Oster et al has ventilation ports 63. The provision of raised ventilation port to a shell or structure to provide better ventilation is well-known, and does not provide any unobvious result, and therefore is not patentable. It would have been obvious to an ordinary skill in the art at the time the invention was made to provide raised ventilation port to any structure to provide better ventilation. As for claim 9, note that the use of polyurethane material for a boot portion is well-known in the art. As for claims 11, 14, 18, note the comments relative to claims 1, 2, 4, 6-8, 10, 19 above for the teaching of Oster et al. Note the boot portion 76, 74, 77 attached to the top of the bottom portion of the rigid immobilization plate 30, and a lower removable insole 24. Note that after market, additional shoe inserts are available for removably attached to the top of a lower insole of a shoe. It would have been obvious to an ordinary skill in the art at the time the invention was made to provide an additional upper removable insole to the device of Oster et al for additional cushioning. As for claim 12, note the outer sole 43 (figure 4) of Oster et al. As for claim 13, note that the structure of boot portion 26 of Oster et al provides a circumferential counter. As for claims 16-17, note liner 62 of Oster et al.

Claims 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oster et al in view of Darby et al (5,370,133). Note the comments above for the

Art Unit: 3764

teaching of Oster et al. While Oster et al does not teach the recited fastening means of claims 20-28, Darby et al teaches this type of fastening means for a brace. In view of the teaching of Darby et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to substitute the fastening means 90 of Oster et al with the fastening means of Darby et al. The substitution of one type of fastening means for another well-known type of fastening means in the art is a matter of obvious engineering design choice, and does not provide any unobvious result, and therefore is not patentable over prior art.

Applicant's arguments filed on 9/20/04 have been fully considered but they are not persuasive. Applicant argues that Oster et al does not teach an immobilization plate includes a back portion formed by a back part ..... with the back part being integrally formed with the side parts.... The examiner disagrees. Note the comments relative to the claims above . Oster et al teaches a rigid immobilization plate 30 ( and 28) with a bottom portion having a back end , a back portion 34( figure 2) formed by a back part that extends up from the back end of the bottom portion, and sides parts that extend up from sides of the bottom portion, the back part being "integrally formed" with side parts 32.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3764

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272 - 4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

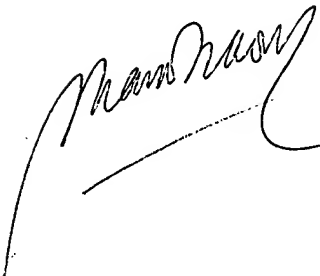
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/985,923

Page 6

Art Unit: 3764

December 15, 2004

A handwritten signature in cursive script, appearing to read "Mam Nguyen", is written over a long, sweeping horizontal line that extends from the left margin towards the center of the page.Handwritten initials "JY" in a stylized, cursive font.

JUSTINE R. YU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

12/16/04